



DOCKET NO.: 2154.001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS

In re: The Application of:

INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

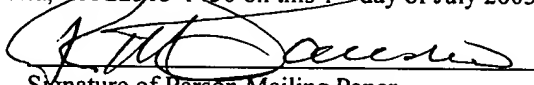
EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this paper is being mailed, via U.S. Post Office First Class Mail, to Mail Stop: Board of Patent Appeals, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on this 1st day of July 2005.


Signature of Person Mailing Paper

Richard M. Saccocio

Printed Name of Person Mailing Paper

Mail Stop: Board of Patent Appeals
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL LETTER

Transmitted herewith for filing in the above referenced application and appeal are:


Applicant Rodger Burrows Brief on Appeal in triplicate.
Fee for filing the brief in the amount of \$250.00
Post card

The Commissioner is hereby authorized to charge the above fees and any additional fees to Deposit Account No. 19-0010.

07/07/2005 MWOLDGE1 00000009 09910654

01 FC:2401

250.00 OP


Richard M. Saccocio

Reg. No. 26,800

Attorney for Applicant/Appellant

Fax No.: 954-764-6141

Telephone 954-764-8003

IN THE U.S. PATENT OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES



BRIEF OF
APPELLANT RODGER BURROWS
UNDER 37 C.F.R 1.191

IN RE: The Application of:

INVENTOR: Rodger Burrows

GROUP ART UNIT: 3622

SERIAL NO.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

**TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY
STORING TRAVEL AGENT COUPONS**

**Law Offices Of
Richard M. Saccocio, PA.
Attorney For Appellant
100 SE 12th Street
Ft. Lauderdale, FL 33316**

July 1, 2005

**BRIEF OF
APPELLANT RODGER BURROWS
UNDER 37 C.F.R 1.191**

In re The Application Of:

INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

The following brief is hereby submitted in accordance with 37 C.F.R. 1.191

1. **REAL PARTY IN INTEREST**

Rodger Burrows is the real party in interest.

2. **RELATED APPEALS AND INTERFERENCES**

A previous appeal before this board was had in Appeal No. 2004-2110. There are no other related appeals and interferences.

3. **STATUS OF CLAIMS**

Claims 1-18 are pending in the applications and are the subject matter of this appeal as follows:

Claim 1. Once amended in accordance with the amendment filed and mailed on July 7, 2003, stands rejected.

Claim 2. Unamended, stands rejected.

Claim 3. Unamended, stands rejected

Claim 4. Unamended, stands rejected.

Claim 5. Unamended, stands rejected.

Claim 6. Unamended, stands rejected.

Claim 7. Unamended, stands rejected.

Claim 7. Unamended, stands rejected.

Claim 9. Unamended, stands rejected.

Claim 10. Unamended, stands rejected.

Claim 11. Unamended, stands rejected.

Claim 12. Unamended, stands rejected.

Claim 13. Unamended, stands rejected.

Claim 14. Unamended, stands rejected.

Claim 15. Once amended in accordance with Appellant's communication of October 17, 2003, stands rejected

Claim 16. Original . Cancelled.

Claim 17. Once amended, stands rejected.

Claim 18. Unamended, stands rejected.

4. STATUS OF AMENDMENTS

The amendment filed on July 17, 2003 was entered by the Examiner.

The amendment filed on October 17, 2003 comprising an amendment under 37 C.F.R. 1.129 (a), was not initially entered by the Examiner in accordance with his communication of October 28, 2003. However, in response to an inquiry by the BPAI, the Examiner subsequently entered said amendment. Thus, the claims in issue in this appeal are 1-15, 17 and 18.

5. PROCEDURAL STATUS OF THE APPLICATION

In a previous appeal of this application the BPAI overruled the Examiner's final rejection, but rejected all of the claims based on a new ground of rejection (see the decision of January 25, 2005 filed on March 28, 2005). Applicant fled a timely Request to Reopen Prosecution on March 25, 2005 together with new evidence and arguments directed to the new ground of rejection. On May 24, 2005 the Examiner responded to Applicant's Request to Reopen Prosecution, again finally rejecting all of the claims. This timely appeal followed.

6. SUMMARY OF THE INVENTION

The invention herein comprises methods and apparatus for electronically generating, and storing airline agency coupon data whereby the data is simultaneously and uniquely generated with the printing of an airline ticket, which data is then stored electronically in data storage apparatus in a director/directory/data file, the data being

given an identifier, which data is thereafter retrieved and printed in a format of a prior art agent coupon.

The inventive method and apparatus uniquely generates the coupon data while the travel agent prior art reservation system prints the airline ticket. However, unlike the prior art reservation system, the agent coupon is not printed. The invention advantageously eliminates the prior art printing of an agent coupon and allows the uniquely generated coupon data to be electronically stored as data and not an image while allowing the data to be retrieved at a later time and printed as an actual facsimile of the agent coupon. Since the agent coupon is not printed at the time that the airline ticket is printed, the need for the travel agent to store the vast numbers of printed agent coupons is eliminated. Moreover, the invention does not require a travel agent to produce a paper agent coupon, copy the same and then store the copy prior to discarding the paper coupon.

7. ISSUES

ISSUE NO. 1

Whether the Examiner's rejection of claims 1-15 and 17-18 under 35 U.S.C. 103(a) is proper on the basis that "although ARC in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction as an image.", notwithstanding the new evidence and argument

submitted by Applicant in his Request to Reopen Prosecution and Response of March 25, 2005.

8. GROUPING OF CLAIMS

The claims of the group 1, 5 and 15, 17, 18 are separate groups that do not stand or fall together. Claims 1, 5 are method claims; claims 15, 17, 18 are apparatus claims. Because of the different limitations in each group, the Examiner's statements of obviousness in making the combination are not equally applicable to each group.

9. ARGUMENT

- i.) The claims were not rejected under 35 U.S.C. 112, first paragraph; therefore, no argument is made in this regard.
- ii.) The claims were not rejected under 35 U.S.C. 112, second paragraph; therefore, no argument is made in this regard.
- iii.) An argument is presented to the above stated issue, i.e. the examiner erroneously rejected claims 1-15 and 17, 18 under 35 U.S.C. 103(a).

(a) Brief Background

A brief summary of the relationship of the parties referred to in the documents submitted by Applicant and which form part of the record on appeal is deemed helpful to allow the board to fully consider the issues herein. This relationship summary is not new argument; all is contained within the submitted documents. Applicant is an

individual who operates an independent travel agency. The Airline Recording Corporation (ARC) is an quasi independent organization funded by the airline industries that interfaces with independent travel agencies that issue airline tickets and from time to time issues policy statements intended to further the goals of the airline industry and provide uniformity to the issuing of airline tickets by the independent travel agencies and the records kept by the travel agencies. Thus, ARC may be said to be the policy arm of the airline industries vis-a-vis the independent travel agencies in the field of airline reservations, tickets, and associated records. The entire body of the travel agents must conform to the dictates issued by ARC. The Industries Agency Handbook (IAH), issued by ARC contains all of the policies that the independent travel agents must comply with in order to be approved by ARC and be allowed to issue airline tickets.

Each travel agency has equipment known as the travel agent reservation system which is used to generate all of the documents required by ARC and concerned with the issuance of an airline ticket by the travel agent. One of the required documents is called an agent coupon. The agent coupon contains all of the data concerning the airline ticket and is the only record kept that allows ARC , the airlines, and the travel agent to later review the ticket transaction. A long standing requirement of ARC was to have the travel agents keep hard, paper copies of the agent coupon for a minimum of two years. Obviously, the same was as great inconvenience to the travel agents. Recently, ARC somewhat relented on this policy and allowed the travel agents to maintain the actual image of the agent coupons on film (microfiche) or other optical

medium. The storage of the data on the agent coupon was and still is prohibited by ARC. ARC still requires the image of the coupon to be stored. ARC has never disclosed a method by which the image of the coupon is stored. ARC has only issued the requirement that the image be stored.

Applicant does not work for ARC; rather Applicant is an independent travel agent

Another party reflected in the documents submitted by Applicant is the Travel Weekly News which is a weekly publication that reports on various travel related news, which news is accessible to the independent travel agencies. Upon information and belief, Travel Weekly News is a completely independent news organization. As further reflected in the submitted documents, the Travel News Weekly reports on Agent Issues which concern ARC's policies and requirements in general, and in particular, the subject matter of the invention herein.

As noted above, in further of its control of the documents generated by the travel agents , ARC issues an Industries Agent Handbook (IAH) that is required to be followed by the independent travel agents. In accordance with the IAH, travel agents are required to create and retain physical copies of an agent coupons for a minimum of two years. This requirement is stated in the application under the Description of the Prior Art. Further information of the data contained on the agent coupons and the requirement for the long time storage of the same is also recited in the application in the Description of the Prior Art.

Since Applicant is an independent travel agent, he was fully knowledgeable of the desire and efforts by the travel agents to eliminate the agent coupon two year storage requirement and the only relaxation of the requirement offered by ARC. Applicant also realized that ARC's relaxation of the rules was of no real benefit to the travel agents. The relaxation merely allowed the travel agent to destroy the paper copy of the agent coupon after it was printed and its image was stored on film or an optical medium (which did not include a hard drive). Thus, ARC's new policy eliminated the requirement to store paper agent coupons but in its place required the agents to expend the effort and time to transfer the image to film or an optical medium. Applicant knew there had to be a better solution to this problem

The better solution is Applicant's invention which does not store an image of the agent coupon. After months of effort, trial and error and research, Applicant perfected his invention which involves a method contrary to ARC's proposed solution. Applicant made arrangements with ARC to meet with authorized representatives and demonstrate his invention. After the demonstration of the operation of the invention, ARC's representatives reported that it produced the unexpected result of storing data which thereafter could be used to print an actual facsimile of the agent coupon.

Interestingly, while ARC to this day still requires the storage of the image of the agent coupon, ARC copied Applicant's invention and has subsequently implemented Applicant's invention as a paid service to travel agents. Upon learning of this information, Application successfully petitioned to make the application special. The special status continues to date.

(b) Legal Arguments

(1) Introduction

In the final rejection of May 24, 2005, and responding to Applicant's argument in the request to reopen prosecution, the Examiner essentially adopted the Board's new ground of rejection in its decision of January 1, 2005, (that is that "...although ARC in its entirety seems to suggest an optical storage of image data, an artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction of the image.", Office Action of May 24, 2005. page 3, lines 8-10. The Board's decision (and now, the Examiner's decision) was based on prior art comprising transmissions over a communications channel such as a facsimile transmission or a multimedia network transmission.

In all fairness, the Examiner attempted to supplement the Board's new ground of rejection by putting forth his own statements in support of the Board's basis. As shown in more detail below, the Examiner's statements in support of his final rejection are of no merit and are self contradictory.

(2) The Examiner Has Misconstrued Applicant's Invention And ARC's Disclosures.

In the decision of January 25, 2005, the Board overruled the Examiner's basis of rejection under 35 U.S.C. § 102 (f) and under 35 U.S.C. § 103 as based on the Friedes prior art. But then the Board entered a new ground of rejection under 35 U.S.C. § 103 stating that even though ARC does not disclose electronic storage of data as found by the Examiner, ARC discloses the storage of coupon data in optical form. Thus, the Board reasoned that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that the coupon data should be stored in optical form. The Board then stated that it was well known in the art to store image data in electronic form so that it could be transmitted over a

communications channel such as a facsimile transmission or a multi-media network channel. The Examiner completely adopted the Board's findings and conclusion in his final rejection.

With all respect, Applicant submits that the Appeal Board and the Examiner have misconstrued Applicant's invention and what is being claimed by the Applicant in advancing the new basis of rejection under 35 U.S.C. § 103; in addition the Board and the Examiner have misinterpreted ARC's disclosures and Applicant's prior appeal arguments. In all probability, the misconstruction in part stemmed from the necessity of Applicant's prior appeal arguments to address the inventorship issues of rejection raised by the Examiner in his first final rejection, which the Board emphatically overruled. In Appellant's Briefs, Applicant quoted the Examiner's stated basis of rejection based on the ARC disclosures and relied on by the Examiner. Applicant's brief also countered the Examiner's basis by quoting ARC's disclosures that contradicted those selected by the Examiner. The Examiner's quoted disclosures and Applicant's quoted disclosures in opposition as stated in Applicant's appeal briefs are incorporated herein by reference to the extent that the same is necessary. It is therefore submitted by Applicant that the Board's and the Examiner's misconstruction of Applicant's invention stemmed from comments and or arguments to counter the Examiner's overruled basis of rejection. Fortunately, this appeal concerns only one issue and the arguments made herein will not be affected by any spillover from other issues.

In Applicant's prior appeal arguments, incorporated herein by reference, it was argued that ARC only disclosed the storage of an *image* of the agent coupon and not the electronic storage of *agent coupon data*. However, in its decision, the Board stated

Appellant responds that when all of the disclosures of ARC are considered as a whole, it is clear that ARC did not contemplate the electronic storage of agent coupon data (reply brief, pages 2-5, 7-11)

We will not sustain the Examiner's rejection of the claims under 35 § 102 (f). **We agree with applicant that ARC, when considered**

in its entirety, only discloses that agent coupon data should be stored in optical form The attempt by the Examiner to read electronic storage of coupon data into the ARC disclosure is based on pure speculation.”, (pages 5-6, emphasis supplied).

Applicant did not make the argument (in bold above) which the Board says and the Examiner adopted, that Applicant agreed to, i.e., that ARC only discloses that *agent coupon data* should be stored in *optical form*. As evidenced in Applicants prior appeal, Applicant argued that ARC disclosed the *optical storage of the actual image* of the agent coupon and not the *electronic storage of agent coupon data*. Thus, Applicant’s prior appeal argument centered on the distinction between image and data. Notwithstanding the misstatement of Applicant’s appeal argument, the Board correctly reversed the Examiner’s rejections. However, the misstatement of Applicant’s prior appeal arguments which formed the basis of the new ground of rejection by the Board and adopted by the Examiner, is not supported by the record. Clearly the only disclosure made by ARC is that the *image* of the agent coupon is to be stored; and, not that the agent coupon *data* should be optically stored. In fact, it was clearly pointed out in the prior appeal that ARC would not approve any system that include the storage of coupon *data* in any form. ARC insisted that the *image* of the agent coupon had to be optically stored. Thus, the Board, and now the Examiner, have misconstrued Applicant’s prior appeal arguments and ARC’s disclosures and then used this misconception to arrive at the new ground of rejection. There is no support in the record to the misconception of Applicant’s arguments and neither the Board nor the Examiner provide such record support.

In furtherance of its decision, the Board later stated “We incorporate the findings made by the Examiner ...except for the finding that ARC discloses the electronic storage of coupon data.”, (page 11, lines 8-11). What other findings of the Examiner the Board incorporated in its decision is not spelled out. The Board further stated on page 11, lines 11-16, “Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the Examiner [which

argument the Applicant did make on appeal] we agree with the Examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings of ARC that coupon *data* should be stored in optical form." (emphasis supplied). Thus, while the Board agreed that ARC's disclosures do not in any way teach the electronic storage of coupon data, the Board advanced that ARC's disclosure teaches optical storage of coupon *data*. The Examiner has in his final rejection adopted this argument. This is a completely erroneous statement of the teachings of ARC. As continually argued by Applicant, the only teachings of ARC is to optically store the *image* of the agent coupon.

As noted above in Applicant's briefs, ARC consistently stated, that ARC's disclosure was to store the agent coupon in optical form. Again there are two aspects to ARC's disclosure, i.e., coupon image, and coupon data. Most importantly, Applicant's claimed invention does not involve a method where the image of the agent coupon is generated from the prior art reservation system, nor where optical storage is used. Claim 1 recites *coupon data* and *electronic storage of the data*. The specific language of these claim limitations is in part critical to a determination of obviousness. The Board and now the Examiner, however, materially deviated from this specific language as follows where it is stated,

...At the time the application was filed, it was well known in the art to store *image data* in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multi-media network channel. Thus, although ARC in its entirety seems to suggest an optical storage of *image data*, the artisan would have found it obvious to also store the *image data* in electronic form for subsequent reconstruction of the image.

In the final rejection of May 24, 2005, the Examiner quoted and adopted the Board's language, above. Based on this statement by the Examiner, Applicant submits that the Examiner erroneously believes that Applicant's invention is the taking of the data from the image of the agent coupon from the prior art reservation system and is applying the factors of obviousness to this step. The claimed invention, as shown in Figure 1, states that agent coupon data is *generated* from the prior art reservation

system. If applicant's invention were to simply take the agent coupon image data and store it, the result would be the storage of the agent coupon itself as an image and not data. Thus, the inventive method does not take the data from the image created and printed by prior art reservation system and store it.

Further, ARC never mentioned the words "image data." The combination of the words "image" and "data" is a creation of the Examiner and the Board. Since an image is not data and data is not an image, as the words are commonly used, the meaning of "image data" as used by the Examiner is not clear. The only possible interpretation that Applicant can ascribe to these words are that an image is created and then data is somehow taken from the image. This is not applicant's invention. At the time the data is generated, no image exists. No image is created in applicant's invention until the data stored as data and then configured as an image. Therefore, the Board inappropriately mixed words to arrive at its conclusion, which conclusion was adopted by the Examiner in his second final rejection. It was Applicant who claimed the limiting words "agent coupon data" in claim 1, not ARC, and not in the mixed manner, i.e. "image data", now stated by the Examiner. Simply stated, ARC's goal was to allow elimination of paper copies of the agent coupon but in its place store the optical image of the agent coupon. While on its face this goal is seemingly simple but in actuality it is not because the then reservation system only had the ability to print an agent coupon and not optically store the image. In fact there is still no presently existing method to allow the prior art reservation system to eliminate the printing of an agent coupon or to optically store the image of the agent coupon without first printing the agent coupon.. ARC recognized this inability and that is why it dictated that the image be stored on microfiche film or other optical media. Moreover, in order to store the image of the agent coupon on microfiche or other optical media, the image had to be physically created and then copied onto the film. Alternatively, if the agent coupon was to be optically stored by electronic means as an image, the image had to physically exist in the first place. The only way for the agent coupon to initially exist in accordance with the then agent reservation system was to print the agent coupon and

then copy the image and then store it as an image. In other words, ARC simply disclosed that it was acceptable to optically store the image of the coupon in lieu of storing paper copies of the coupon. ARC never disclosed or suggested that it was permissible or possible to store agent coupon data in lieu of storing paper copies of the agent coupon.

A conclusive showing as to what ARC disclosed in 2000 (at the time of the application) and in 2005 (at the present time) is shown in the applicable sections of the 2000 IAH and the 2005 IAH, Exhibits 1 and 2 respectively.

In the 2000 IAH handbook, Section 70.0, (Exhibit 1)ARC stated:

As an alternative to maintaining supporting documents in paper format, an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions.

(1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a "write once, read only" technology which will prevent overwritingHowever, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable.
(emphasis in the original)

In the 2005 IAH handbook, Section 70.0, (Exhibit 2)ARC stated:

As an alternative to maintaining supporting documents in paper format, an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions.

(1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a "write once, read only" technology which will prevent overwritingHowever, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable.
(emphasis in the original)

As can be seen, the 2000 and the 2005 handbooks read exactly the same. Thus, without doubt, ARC disclosed and still requires that an agent coupon and other sales and supporting documents be "copied" and then stored. "Copied" necessitates that the

document first be in a physical format, in other words printed and then stored optically or otherwise. Data storage by any magnetic media was and is still prohibited. Thus, it cannot be stated that ARC disclosed that agent coupon *data* nor coupon image data should be stored in optical form .

(3) The Problem Faced And Solved By The Applicant

Realizing the futility and extra effort involved in ARC's suggestions and permissible deviation from storing paper (printed) agent coupons, Applicant believed that there had to be a better solution. Discarding the paper coupon after it was printed and then optically transferred to film or an optical media eliminated one requirement but then created another. The better solution would be to eliminate the paper (printed) coupon altogether. Thus, the problem faced by the Applicant was to eliminate the necessity to first print the agent coupon and then optically store it. As explained above, the task could not be accomplished by ARC's disclosures because of the inherent inconsistency in requiring that the coupon be first printed and then its image be stored as a means to eliminate the physical storage of agent coupons.

Applicant's invention overcame this apparent inconsistent feat by the unique solution disclosed and claimed in the subject application which solution does not involve first printing the coupon and then optically storing it.

The problem faced by the inventor is one factor in determining the issue of obviousness. The problem faced by the Applicant was to achieve ARC's goal of eliminating storage of paper agent coupons, but not by using the method disclosed or suggested by ARC. In order to do this the Applicant invented the method involving the steps of generating agent coupon data simultaneously with the printing of the airline ticket while using the then available agent reservation system, and then storing the coupon data in electronic form and not in optical form.. In the prior art as explained in the specification of the application, the agent coupon was printed along with the printing of the airline ticket. In stead of storing paper (printed) agent

coupons, ARC wanted the image stored in an optical media after it was printed, e.g. microfiche. It absolutely did not want the agent coupon data to be stored, see the ARC quotes in the 2000 and 2005 IAH . Accordingly in a direction away from ARC's teaching, the Applicant invented the method of generating agent coupon data using the prior art agent reservation system, as shown in Figure 1 of the drawings, during the time that the airline ticket was being printed. Then the generated coupon data was separated from the prior art reservation system, identified and the data was electronically stored for future printing in the exact form of a prior art agent coupon, all in a manner not previously known or suggested. Applicant's invention therefore achieves the ability to completely eliminate the printing of an agent coupon during the printing of an airline ticket and not storing an optical image of the coupon. Applicant's claimed invention further provides the ability to print an exact copy of the agent coupon at a future time from the stored data and not from a stored image of the coupon. In this regard, Applicant's claimed invention is completely different from ARC's disclosures or any suggestion in ARC's disclosures.

(4) The Examiner's References Do Not Teach Or Suggest Applicant's Invention

In the second final rejection, the Examiner adopted the Board's misinterpretation of ARC's teachings to be the optical storage of *image data*, as well as the Board's prior art reference of facsimile transmissions as applicable to the issue of obviousness (page 3). In this regard, the Examiner committed clear error. The facsimile reference might be applicable if Applicant had claimed the electronic storage of the *image*. Applicant however has claimed the electronic storage of the generated data. This is a distinction with a difference. As noted above "image data" can only mean that data is taken form an image, although how this is accomplished is not stated by the Examiner, requires that an image first exist. Contrarily, coupon data involves no image, just data. Applicant submits that the facsimile analogy is therefore misplaced in that the technology involved in facsimile transmission is that of an image broken down to white and black bits of information each of which is transmitted as an

image and not data. See attached Exhibit 3 being an article entitled “How Fax Machines Work”, which exhibit is incorporated herein by reference. For the Board and the Examiner to find that the technology involved in Applicant’s claimed invention was the same as a facsimile machine is therefore obviously erroneous.

The Board’s and Examiner’s other reference to storing “image data” in electronic form and transmitted using a multi-media network is also misplaced. Certainly data can be transmitted within a network and an image can be transmitted within a network. But that also is not Applicant’s invention. Applicant’s invention generates data but not from an image. Moreover, coupon data that is transmitted in a network cannot be later configured as an image of an agent coupon unless Applicant’s invention is used.

As stated above, the words “image data” are confusing and not explained by the Examiner. It is either an image or data, but not both. And, the Examiner nor the Board have explained what is meant by image data being stored in electronic form. It is believed by Applicant that the Examiner and the Board are referring to transmitting data, either as raw data or incorporated in a document, from one computer to another using a network arrangement. If Applicant’s understanding is correct, this example cited by the Board is again misplaced. Certainly data, raw or in a form, can be sent from one computer to another, but that is not Applicant’s invention and concerns only one step of the method claimed by Applicant. The law is clear that a claim can incorporate elements of the prior art in a claim, but the invention as a whole as claimed must be considered in an obviousness issue. Thus, even if the reference to a multimedia network has any validity, nothing in the prior art which the Board or the Examiner have collectively labeled as “ARC” in combination with a multi media network system suggests or teaches the step of generating the agent coupon data as shown in Figure 1 and stated in Claim 1. The Examiner’s argument in support of obviousness does not address the whole of claim 1 and is legally insufficient.

Interestingly, the Examiner argues that because ARC stated that computer hard drives are not acceptable, this discloses that alternate means for storing the supporting

documents, including the agent coupon was not only known but considered by ARC and therefore Applicant's invention is obvious. The Examiner is completely misinterpreting ARC's statement and the then known art. In order to properly interpret the statement relied on by the Examiner, the complete IAH statement must be considered as well as other statements by ARC. The introduction to the statement begins with the allowed practice of eliminating paper coupons and "...an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions." The following condition prohibits storage of the documents on hard drives- not the storage of the data on hard drives. Storage of data is completely prohibited by ARC. Thus, the proper interpretation of the portion relied on by the Examiner concerns prohibiting the copying an image of the coupon on a hard drive. Therefore, the image must be created before any storage takes place or is suggested. With the prior art then existing and even today, there is no ability to copy the coupon without first creating an image of the coupon. Thus, ARC stated that after the coupon is produced as a document, it is not permissible to copy the image to a hard drive. This is not Applicant's invention. It is also to be remembered that ARC stated "If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."

A further showing of the Examiner's misinterpretation is the Examiner's contradictory statements "This citation does not state that an *optical image* of the agent coupon is being *stored*, only that the required *documents* (which would include the agent coupon) may be *stored* on an optical storage medium that cannot be overwritten." (page 4 lines 17-20, referring to the IAH quote by ARC). And the Examiner's statement on page 3 lines 12-13, "ARC stated ...all supporting *documents* must be *copied* to microfiche/film ..." The words "copied" and "storage" as used by the Examiner are therefore mutually exclusive rendering the Examiner's statements contradictory and not possible to form a basis of rejection under 35 U.S.C. § 103.

(5) The Examiner Has Not Make A Showing Of A Prima Facie Case Of Obviousness

While Applicant agrees in general with the law cited by the Board and adopted by the Examiner, regarding a prima facie case of obviousness, it is submitted that the Examiner has failed to show a prima facie case of obviousness in accordance with the cited law. In the absence of a showing of a prima facie case of obviousness, an applicant is entitled to a patent, In re Rouffet, 149 F.3d 1350 (CAFC 1998). A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. The constituent factual findings for a prima facie case of obviousness are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the prior art and the claimed invention, In re Greene, 1999 U.S. App Lexis 32002 (CAFC 1999).

In re Fine 837 F.2d 1071 (CAFC 1988) is another case applicable to the lack of showing of a prima facie case of obviousness by the Examiner. There the court reversed the Board's showing of prima facie case of obviousness. The court stated that the burden can only be satisfied by showing some objective teaching in the prior art or knowledge that is generally available to one of ordinary skill would lead that individual to combine the references. Then the court noted that both the Board and the Examiner baldly stated that the substitution was within the skill of the art but pointed to nothing suggesting the combination or provided support for the bald assertion.

It is well known that a ticket reservation system includes a main frame, a computer and a printer. It is also well known that the prior art ticket reservation system prints an airline ticket and prints an agent coupon. ARC's disclosures permits the travel agent to optically store the agent coupon which can only be done after the agent coupon is printed and then allows the travel agent to discard the printed or paper copy of the agent coupon. As noted above, Applicant realized that ARC's disclosure or permission was in reality of little benefit to a travel agent. While eliminating the necessity to physically store paper agent coupons, it required the images to be scanned

and then stored. Arc's disclosures did not suggest or teach the elimination of an image of the agent coupon, but rather that the paper copy of the coupon can be discarded after its image is stored. Accordingly, Applicant sought to devise a method that both eliminated the need to store paper agent coupons and eliminated the need to print an agent coupon and then optically scan it and store the image. Applicant's claimed invention accomplishes these objectives. In the specification, on page 4 lines 10-12, it is stated that the inventive method includes the data being obtained directly from the reservation system as shown in Figure 1. In other words, the coupon data is generated from the information stream from the reservation system, and since the reservation system, in the inventive method, does not print the agent coupon, the coupon data is generated from the reservation system flow of information. Claim 1 includes the limitation "generating agent coupon data simultaneously with the printing of an airline ticket". Figure 1 shows that the agent coupon data (13) is taken from the ticket reservation system (11). Inasmuch as ARC's disclosures in combination with the technology of a facsimile machine transmission and/or in combination with a multi media network transmission does not result in Applicant's claimed invention, a prima facie case of obviousness has not been shown by the Examiner is adopting the Board's new basis of rejection.

In re Lee 277 F. 3d 1338, (Fed. Cir. 2002), is yet another case applicable to the lack of showing of a prima facie case of obviousness by the Board. The In re Lee court held that the factual inquiry whether to combine references must be thorough and searching and that it must be based on objective evidence of record. The court further held that: the agency must articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made; omission of a relevant factor required by precedent is both legal error and arbitrary agency action; reasoned findings are critical to agency performance and judicial reliance on agency competency; general conclusions about what is common knowledge or common sense are not sufficient to support agency findings; common knowledge and common sense,

even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. With regard to the above holdings, the Court stated:

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F. 3d 1350, 1359, (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. "); *In re Fritch*, 972 F. 2d 1260, (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Dembicazk, 175 F.3d 994 (Fed. Cir. 1999) the court also stated that the best defense against the subtle but powerful attraction of hindsight based obviousness is a rigorous application of the requirement for showing of the teaching or motivation to combine the prior art references. Here, the Examiner made no such rigorous showing of the teaching or motivation to combine the references cited. Rather the Examiner merely advanced a conclusory statement that because facsimile technology and multi media networking technology was well known to store "image data", it would be obvious to store "image data" in electronic form for subsequent reconstruction as an image. Again the meaning of "image data" is critical. Does it mean an image or data? If it means an image, that is not Applicant's invention. If it means data, the prior art does not generate data –it generates an image. Arc's disclosures do not suggest storage of "image data"; ARC never used the words "image data". ARC only suggested storage of the image of the agent coupon. Therefore, it

does not logically or legally follow that it would have been obvious to store the “image data” for subsequent reconstruction of the image.

In In re Lee the Board and Examiner baldly made a statement that no hint of suggestion is needed where common knowledge and common sense are involved. In the present case an equally bald statement is made by the Examiner in advancing his finding of obviousness. The Examiner stated “thus, although ARC in its entirety seems to suggest an optical storage of image data, ...” As noted above, ARC never disclosed or stated the mutually exclusive words “image data”. More importantly, the Examiner baldly used the word “seems” with regard to what ARC suggests. In accordance with In re Lee, the word “seems” has no specificity to indicate what ARC suggests, especially where ARC never used the words “image data”. Without specificity it is not possible for specific findings to exist. Indeed, the Examiner has not in accordance with In re Lee explained how one of ordinary skill in the art would have been motivated to select the references and to combine them, or would have selected these components for combination in the manner claimed to render the claimed invention obvious.

Here, the Examiner cited the art of facsimile machines and multi media networking as prior art which in combination with ARC’s disclosures renders Applicant’s invention obvious. Notwithstanding that the Examiner has misinterpreted and misconstrued ARC’s disclosures and Applicant’s invention, as explained above, the Examiner has not explained how the technology involved in that art functions to render Applicant’s invention obvious as required by In re Lee. Then too, as Applicant explained herein, the operation of the facsimile transmission is different from Applicant’s claimed method and the multi media citation at best only concerns the data transmission step of Applicant’s claimed method. Thus, the Examiner’s finding does not consider Applicant’s invention as a whole and runs afoul of this well accepted principle of law.

The Examiner’s finding makes no attempt define the level of ordinary skill in the art of the invention as required by Graham v. John Deere, 383, U.S. 1 (1966) and

In re Greene, supra. This lack of determination is sufficient in and of itself to render the Examiner's finding clearly erroneous.

Accordingly, the Examiner's findings do not comply with the required factual findings for a prima facie case of obviousness. That is, the Examiner has not determined the scope and content of the prior art; the level of ordinary skill in the art; or, the differences between the prior art and the claimed invention, Graham v. John Deere; In re Greene, supra.

(6) Applicant's Further Rebuttal To The Examiner's Finding Of Obviousness

Notwithstanding that Applicant does not agree that the Examiner has made a showing of a prima facie case of obviousness, the following rebuttal is submitted. 35 U.S. § 103 is the ultimate controlling authority as interpreted by the Federal Circuit for the issue of obviousness, which in effect states that a person cannot obtain a patent if the subject matter of the invention is considered obvious to a person of ordinary skill in the art to which the invention pertains, Graham v. John Deere, supra. In assessing the issue of obviousness the factors to be considered are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the prior art and the claimed invention, Id.

The prior art as stated by the Examiner are the ARC disclosures, the facsimile machine and a multimedia networking arrangement. As noted above, Applicant's position of the ARC disclosures is that paper agent coupons can be eliminated provided that an image of the agent coupon is optically stored. The Examiner's interpretation of the ARC disclosures is that optical storage of an agent coupon "image data" should be stored. With regard to these different interpretations of what the ARC disclosures teach or suggest, Applicant incorporates herein all of the above statements and arguments pertaining to this factor. Accordingly, Applicant submits that the Examiner's interpretation is unwarranted and not supported by the record. On the other hand, Applicant's interpretation of the scope and content of the ARC disclosures

are as stated in the IAH handbook published at the time of the application as well as all of the statements made by ARC with regard thereto

“If you’re using a type of optical storage media, we’re talking about capturing the image of the coupon, not creating a database.”

Allan Muten, ARC corporate communications director, as reported in the Travel Weekly News dated 6/20/2000 (doc. AM, Form PTO 1449)

Applicant submits that the above single quote by ARC and the consistent IAH statements of 200 and 2005, firmly put to rest any question of the interpretation of the ARC disclosures. Nothing could be more clear. Applicant’s interpretation is correct, the Examiner’s is erroneous. In view of the only supportable interpretation of the ARC disclosures, the facsimile and multi media networking references cited by the Examiner are totally inapplicable or at the very best apply to one step of the Applicant’s claimed invention, as explained above. In either event, the combination of the references do not teach or suggest Applicant’s claimed invention; or in the alternative do not address Applicant’s invention as a whole. Accordingly, the Applicant has rebutted the Examiner’s determination of the scope and content of the prior art. Applicant has also shown that the differences between the prior art and the claimed invention do not support a finding of obviousness, see the above. (Applicant still maintains that the Examiner has not shown any authority to support a different conclusion, as explained above).

In his decision, the Examiner has not made any attempt to determine the factor regarding the level of ordinary skill in the art. Exhibit 4, attached to Applicant’s request to reopen prosecution, is a declaration of the Applicant that shows the history of his invention and that his level of skill in the art is superior to one of ordinary skill

The copies of the pertinent portion of the 2005 IAH (Exhibit 2) reveals that ARC is still disclosing the need to optically capture the image of the agent coupon as did the 2000 IAH (Exhibit 1) at the time of the application. Thus, it is shown that ARC and others, other than Applicant, have failed to make Applicant’s invention for over 5 years based on ARC’s disclosures. Even if the level of skill in the art is considered high, the failure of others to make Applicant’s invention for at least 5 years

based on ARC's disclosures evidences that a person of ordinary skill has not considered Applicant's invention obvious. That Applicant's invention has satisfied a long felt need is also shown by the years apart statements by ARC regarding the same optical storage of the image of the agent coupon disclosures by ARC.

Accordingly, a full and supportable determination of the Graham V. John Deere factors, as advanced herein leads to the only conclusion that Applicant's invention when taken as a whole, without the prohibited use of hindsight, was not obvious to a person of ordinary skill in the art to which the invention pertains, at the time of the application.

Rebuttal evidence is merely a showing of facts supporting the opposite conclusion and may relate to the Graham factors including the secondary considerations, In re Plasecki, 745 F. 2d 1468 (Fed. Cir 1984). If rebuttal evidence of adequate weight is produced. The holding of a prima facie case of obviousness is dissipated. Moreover, the Examiner must consider all of the evidence anew regardless of the strength or weakness of the prima facie case, *id.* In accordance with the above submitted evidence, Applicants submits that the showing, if any, of a prima facie case of obviousness is dissipated.

(7) The ARC Disclosures Teach Away From Applicant's Claimed Invention

In the prior art as explained in the specification of the application, the agent coupon was printed along with the printing of the airline ticket. In stead of printing and storing paper agent coupons, ARC wanted the image stored in an optical media, e.g. microfiche. It absolutely did not want the agent coupon data to be stored, see the ARC Industrial Agents' Handbook quoted above, Exhibits 1 and 2, respectively. Accordingly in a direction away from ARC's teaching, the Applicant invented the method of generating agent coupon data by extracting the data from the prior art agent reservation system, as shown in Figure 1 of the drawings, during the time that the airline ticket was being printed. Then the generated coupon data was separated from

the prior art reservation system, identified and the data was electronically stored for future printing in the exact form of a prior art agent coupon, all in a manner not previously known or suggested. Applicant's invention therefore achieves the ability to completely eliminate the printing of an agent coupon during the printing of an airline ticket and not storing an optical image of the coupon. Applicant's claimed invention further provides the ability to print an exact copy of the agent coupon at a future time from the stored data and not from a stored image of the coupon. In this regard, Applicant's claimed invention is completely different and away from ARC's disclosures or any suggestion in ARC's disclosures.

Moreover, as explained above, the Examiner's reference to Facsimile transmission is inapplicable in that said technology transmits an image and not data. The Board's reference to multi media networking also falls short of showing obviousness in that it may refer or be applicable to but one step in Applicant's claimed invention and not the invention as a whole.

With regard to an issue of obviousness a reference that teaches away is a significant factor to be considered in determining obviousness. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. In general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the relief sought by the applicant. In re Gurley, 27 F. 3d 551 (Fed. Cir. 1994). Applicant submits that it is inconceivable to find that or reach any conclusion other than the 2000 and the 2005 IAH handbooks teach away from the path taken by Applicant. The path taken by applicant completely eliminates the need to print and then optically store the image of an agent coupon. ARC's disclosures do not render Applicant's claimed invention obvious.

**(8) The Examiner's Response To Applicant's Above Arguments Are
Void Of Any Substance.**

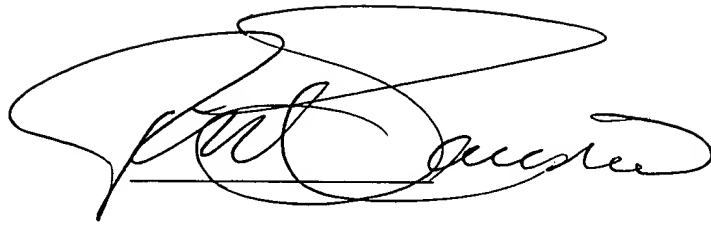
In responding to Applicant's above arguments presented in the request to reopen the prosecution, the Examiner merely stated that the same were not persuasive. However, in an attempt to actually respond to Applicant's arguments regarding the important distinction between storing an image versus storing data, the Examiner confusingly responded that the requirement to "maintain the required documents on microfiche/film or on an optical storage medium....which will prevent overwriting" "... does not state that an optical image is being stored, only that the required documents may be stored on an optical storage medium that cannot be overwritten." It is respectfully submitted that the Examiner's response is not only confusing but not responsive to the factual argument as to what ARC disclosed regarding an image vis-a-vis data. Moreover, the compact disc definition presented by the Examiner is also irrelevant to the distinction between storage of data and the storage of an image.

An even more confusing attempt by the Examiner to respond to Applicant's argument regarding Applicant's claimed the use of a hard drive is directly contrary to ARC prohibition of the use of the same (because it can be overwritten). Some how, the Examiner uses the fact that the ARC's prohibition is a suggestion to use a hard drive. Such reasoning is incomprehensible but probably due to the Examiner's continuous refusal to accept the distinction between an image and data in the references and Applicant's claimed invention.

CONCLUSION

The Examiner has not shown a prima facie case of obviousness in its decision; or in the alternative, and assuming without conceding that it has, Applicant has authoritatively, sufficiently and adequately rebutted the finding of obviousness. Applicant respectfully requests that Board overrule the Examiner's present 35 U.S.C. § 103 rejection and allow the application in its present form.

Dated July 1, 2005.

A handwritten signature in black ink, appearing to read 'R. M. Saccocio', with a large, stylized flourish above it.

Richard M. Saccocio
Attorney For Applicant
Registration No. 26,8000

In re The Application Of:

INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

APPENDIX

CLAIMS ON APPEAL

1. A method for electronically generating, storing, and retrieving airline ticket agency coupon data, comprising the steps of:

generating agent coupon data simultaneously with the printing of an airline ticket;

transmitting and storing said agent coupon data electronically to and in data storage apparatus;

providing each agent coupon data with an identifier;

storing said agent coupon data in a director/directory/image file arrangement; and

retrieving said electronically stored agent coupon data and printing the same in the format of an agent coupon.
2. The method of claim 1, including the step of storing said agent coupon data on a compact disk.

3. The method of claim 1, including the step of storing said agent coupon data on a hard drive.
4. The method of claim 1, including the step of transmitting and storing a plurality of agent coupon data in a batch file format.
5. The method of claim 1, including the step of generating said agent coupon data by airline ticket reservation apparatus.
6. The method of claim 5, including the step of serially connecting said reservation apparatus to said data storage apparatus.
7. The method of claim 5, including the step of connecting said reservation apparatus to said data storage apparatus by a modem.
8. The method of claim 5, including the step of internet connecting said reservation apparatus to said data storage apparatus.
9. The method of claim 5, including the step of intranet connecting said reservation apparatus to said data storage apparatus.

10. The method of claim 1, wherein said identifier comprises an ARC number.
11. The method of claim 10, wherein said identifier includes a sales period ending date.
12. The method of claim 11, wherein said identifier includes a ticket number.
13. The method of claim 12, wherein said identifier includes a passenger's name.
14. The method of claim 13, wherein said identifier includes a record locator.
15. Apparatus adapted to generate, transmit, store and retrieve airline agent coupon data, comprising:
 - airline ticket reservation apparatus; and,
 - data storage apparatus comprising :a computer having a hard drive, said data storage apparatus being electronically connected to said reservation apparatus ;a software program means loaded in said computer for generating agent coupon data simultaneously with generation of an airline ticket, transmitting said agent coupon data to said computer, storing and retrieving said agent coupon data, on memory storage apparatus connected to said computer; and printing means connected to said computer for printing said stored and retrieved agent coupon data in the format of an agent coupon.

17. The apparatus of claim 15, wherein said software program means further includes means for identifying each generated agent coupon data.
18. The apparatus of claim 17, wherein said software program means further includes means for filing each generated agent coupon data in accordance with said identifier means.